

Application No. 10/561,144
Amendment dated July 7, 2009
Office Action of April 9, 2009

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Docket No.: 64656(46590)

REMARKS

In the office Action Dated April 9, 2009, Claims 31, 32 and 52-56 are pending and stand rejected. Claims 31, 32 and 52-54 have been canceled. Claims 55 and 56 have been amended to more particularly point out and distinctly claim the subject matter regarded as invention. Support for the amended claims are throughout the specification and claims as originally filed. Claims 57 and 58 have been added. No new matter has been introduced by the instant amendments to the claims. The scope of the claims is not changed.

Applicants respectfully reserve the right to pursue any non-elected, canceled or otherwise unclaimed subject matter in one or more continuation, continuation-in-part, or divisional applications.

It is submitted that the claims, herewith and as originally presented were in full compliance with the requirements of 35 U.S.C. § 112. The amendment of the claims, as presented herein, is not made for purposes of patentability within the meaning of 35 U.S.C. §§ 101, 102, 103 or 112. Rather, this amendment is made simply for clarification and to round out the scope of protection to which Applicants are entitled. Furthermore, it is explicitly stated that the herewith amendment should not give rise to any estoppel.

Reconsideration and withdrawal of the rejections of this application in view of the amendments and remarks herewith, is respectfully requested, as the application is in condition for allowance.

Applicant now turns to comments made by the Examiner in this Office Action as follows.

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OBJECTION TO THE SPECIFICATION

The specification was objected because the title was not descriptive. The applicants amended the title to "NOVEL SECRETORY OR MEMBRANE PROTEIN EXPRESSED IN SKELETAL MUSCLES", which the applicants believe clearly indicative of the invention to which the elected claims are drawn.

REJECTION UNDER 35 U.S.C. § 112, 2ND PARAGRAPH

Claims 31, 32 and 52-54 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants have canceled claims 31, 32 and 52-54, thus the rejection to these claims becomes moot.

As to claims 55 and 56, applicants deleted the phrase "an amino acid sequence having an identity of " to particularly point out and distinctly claim the subject matter.

REJECTION UNDER 35 U.S.C. § 102(b)

Claims 31, 32 and 52-54 are rejected under 35 U.S.C. § 102(b) as being anticipated by Lanctot et al. (US Patent Application Publication, US 2003/0125258, published Jul. 3, 2003).

Applicants canceled claims 31, 32 and 52-54 and thus the rejection becomes moot.

As to claims 55 and 56, these claims recite active step of "3) confirming that the test substance does change the ability of the protein to bind to its receptor by demonstrating that sugar uptake is suppressed under insulin stimulation in skeletal muscle cells" and "3) confirming that the test substance does change the ability of the

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protein to bind to its receptor by demonstrating that glycogen synthesis is suppressed in skeletal muscle cells", respectively. Lancot et al. does not mention, refer to, or make any citation to this step. Therefore, Lancot cannot anticipate either claim 55 or 56. Applicants respectfully request reconsideration.

CONCLUSION


In view of the remarks made herein, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are respectfully requested.

FEE AUTHORIZATION

The Commissioner is authorized to charge the extension fee and any other fees associated with this submission to our Deposit Account No. 04-1105, Reference 64656(46590). Any overpayment should be credited to said deposit account.

Dated: July 7, 2009

Respectfully submitted,

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